

REMARKS

Claims 87-327 are currently pending in the application. Applicant requests reconsideration of the application in light of the following remarks.

Rejections under 35 U.S.C. §112

Claims 87-326 stand rejected by the Examiner under 35 U.S.C. 112, first paragraph, as allegedly containing subject matter which was not described in the specification with sufficient detail. Namely, the most recent Office Action objected to Applicant's alleged use of several terms without an indication of the meaning of the term, or additionally without any evidence that Applicant uses a component that qualifies within the scope of the term in the pending application. Applicant traverses this rejection.

Applicant is not limited to the nomenclature used in the application as filed. MPEP § 608.01(o). When claims are amended, exact terminology between the specification and the claims need not be used to satisfy the requirements of the first paragraph of 35 U.S.C. § 112. MPEP § 1302.01, ¶ 13.08. Nevertheless, to accelerate prosecution on the merits, Applicant has amended the specification as needed to more clearly identify the proper antecedent basis for the descriptive terminology used in the claims.

The United States Federal Circuit Court of Appeals holds that claim terms are given their ordinary meaning and only if the claim term is ambiguous is there a need to look to the specification. *Vitronics Corp. v. Conceptronic, Inc.* 90 F.3d 1576 (Fed Cir. 1996). "Claim language generally carries the ordinary meaning of the words in their normal usage in the field of invention" at the time of invention. *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1367 (Fed.Cir.2003). Dictionaries and scientific treatises may also help supply the pertinent context and usage for claim construction. *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1201, 1202 (Fed.Cir.2002); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed.Cir.1999).

Thus, to determine the meaning of claim language, one should look at the plain meaning of the term, if that term is ambiguous, reference to the specification, dictionaries and scientific treatises used by skilled artisans at the time of the invention (or earlier) may be used. If a term is defined in the specification, the term is limited to that definition. Although Applicant does not believe the claim terms are ambiguous in the context of Applicant's claims, but has amended the specification as noted above to ensure proper antecedent basis for the descriptive terminology used.

“Mutually Compatible”:

The term “compatible” is defined by the American Heritage Dictionary of the English Language, Fourth Edition as (*see* dictionary.reference.com/search?q=compatible):

1. Capable of existing or performing in harmonious, agreeable, or congenial combination with another or others.
2. Capable of orderly, efficient integration and operation with other elements in a system with no modification or conversion required.
3. Capable of forming a chemically or biochemically stable system.

“Mutually” compatible means the components are compatible with each other. The compatibility of the components in paint and their resulting stable mixture has long been a concern for paint manufacturers. Instable paint is highly undesirable. Those of ordinary skill in the paint industry understand the meaning of the terminology “mutually compatible.” One example of this understanding is found in the Tsuei reference cited by the Examiner (U.S. Patent 5,643,669). Tsuei explains at col. 6, lines 20-26, “‘compatible’ means that the component does not cause adverse affects to the curable composition (e.g. precipitation, flocculation, or other separation of the components), or to the cured coating (e.g., disruption of film continuity, phase separation, or loss of adhesion to the backing).” This is a conventional meaning for the term used in the paint art.

Applicant described its prepaints as being stable (*see* page 2) and these prepaints are also stable when mixed to form usable paint. The American Heritage Dictionary of the English Language, Fourth Edition defines “stable” as (*see* dictionary.reference.com/search?q=stable):

1.
 - a. Resistant to change of position or condition; not easily moved or disturbed.
 - b. Not subject to sudden or extreme change or fluctuation.
 - c. Maintaining equilibrium; self-restoring.
2. Enduring or permanent.
3.
 - a. Consistently dependable; steadfast of purpose.
 - b. Not subject to mental illness or irrationality.
4. Physics. Having no known mode of decay; indefinitely long-lived. Used of atomic particles.
5. Chemistry. Not easily decomposed or otherwise modified chemically.

To be stable, the components are inherently compatible. If they were not compatible, they would by definition not form a chemically stable system. To one skilled in the art of paint applicant did convey that applicant had possession of the invention at the time the application was filed.

“Extender Pigment”:

In the Request for Interference, page 8, Applicant amended the paragraph of the application beginning on page 8, line 20 to include the terminology “extender pigment”. Beginning at page 55, middle paragraph, of the Request, and also on page 59 of the Request, Applicant also explained “extender pigments” and why Applicant’s specification includes “extender pigments”.

The term extenders, or extender pigments, is well known in the paint art to those of ordinary skill in the art and those of ordinary skill in the art would know what applicant intends by this term. Page 108 from the Coatings Dictionary referenced in the Request for Interference is attached hereto as Exhibit D, Addendum. Even in the Coatings Dictionary definition of extender, calcium carbonate and calcined clay are listed as examples of extender pigments. Applicant's use of the term is the ordinary use of the term in the relevant art. As explained in the Request for Interference, natural calcium carbonate is "limestone" (disclosed in Applicant's specification). *See* page 166 of Exhibit D of the Request for Interference and Exhibit D, Addendum attached hereto.

To one skilled in the art of paint applicant did convey that applicant had possession of the invention at the time the application was filed and applicant's specification does teach and suggest the use of extender pigments as they are known in the art.

"Latex Polymeric Binder":

The term "latex polymeric binder" is a descriptive term to refer to binders that are specifically latex polymers. This terminology would be understood by one of ordinary skill in the art at the time of the invention. To clarify the terminology usage and point out specifically the example used in Applicant's specification, Applicant has further amended the specification to include the specific term.

The most recent Office Action asserts there is nothing in Applicant's specification to suggest that applicant uses a latex polymeric binder. In Applicant's Request for Interference, Applicant explains on pages 55 and 56 why the BASF 6183 is a latex polymeric binder. This is a teaching and suggestion to use latex polymeric binders. The most recent Office Action also attempts to rely upon an example in Applicant's disclosure that uses 100% acrylic acrylonitrile resin to assert that this somehow negates the support for a latex polymeric binder. Applicant reminds the Office, however, that the fact that a paint is an acrylic paint does not preclude the paint being a latex paint as well. *See*, for example, Exhibit E of the Request for Interference where BASF

refers to 6183 (Acronal Optive 220) as an “acrylic latex polymer”; *see also*, page 6 of Exhibit D Addendum, attached hereto, which includes an “acrylic latex”. The mixture, for example, could include 100% acrylic latex and still be a 100% acrylic paint. Applicant is permitted to claim his invention broadly. BASF 6183 is an example of a latex polymeric binder.

To one skilled in the art of paint applicant did convey that applicant had possession of the invention at the time the application was filed and applicant’s specification does teach and suggest the use of a latex polymeric binder as it is known in the art.

“Opacifying Pigment”:

The term “opacifying pigment” is a descriptive term to refer to pigments that are used to opacify a composition. This terminology would be understood by one of ordinary skill in the art at the time of the invention. Titanium dioxide is the most widely used opacifying pigment for paint. In fact, the definition of Titanium Dioxide (*see*, page 280 of Exhibit D to the Request for Interference) states that it is a high-opacity pigment. In Applicant’s Request for Interference, Applicant explains on pages 55 and 59 why Applicant’s specification includes an opacifying pigment. The most recent Office Action alleges that an ordinary practitioner in the art would not know which types of pigments are intended by this term. “Opacity” is the degree to which a material obscures a substrate. As explained on pages 213 and 214 of Exhibit D, Addendum attached hereto, Pigments can provide many different qualities to paint, such as opacity, hardness, durability and corrosion resistance. Applicant intends the types of pigments that affect opacity, such as titanium dioxide.

Titanium dioxide is a well known pigment that affects opacity and, despite the Examiner’s assertion that it does not appear to correspond to an opacifying pigment in the manner described by Friel, it is expressly included by Friel as one of Friel’s opacifying pigments.

To one skilled in the art of paint applicant did convey that applicant had possession of the invention at the time the application was filed and applicant's specification does teach and suggest the use of an opacifying pigment as it is known in the art.

“Adsorbed”:

Applicant included at page 60, middle paragraph, of the Request for Interference, an explanation of why adsorbtion is supported by the specification. Although the term “adsorb” is not expressly stated in Applicant's disclosure, the fact that the components when mixed do “adsorb” would be inherent. Due to the nature of the opacifying pigment, extender pigment or flattening agent used with the resinous binder, adsorption inherently occurs. Applicant has not expressly stated it in the specification, but it occurs nonetheless.

“PVC”:

Applicant has amended the specification to include the reference to PVC, pigment volume concentration.

Applicant believes this explanation and the amendments to the specification resolve the section 112 issues associated with the claims. Applicant's use of the terms “mutually compatible”, “extender pigment”, and “opacifying pigment” are intended to be descriptive use of the terms as the common terms are known and would be understood by those of ordinary skill in the art. Applicants respectfully request that the rejection of claims 87-326 under 35 U.S.C. § 112 be withdrawn.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 207-212, 232-234, 237, 243, 244, 301-303, 306, 313, 314, 316, 319, 320 and 327 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuei (U.S. Patent No. 5,643,669, hereinafter "Tsuei"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Each of the independent claims among the claims rejected for obviousness recites combinations of "prepaints". As explained in the Request for Interference, page 55, a "prepaint" is a composition formed in a process prior to forming an actual functional paint and used in conjunction with other compositions in order to form a functional paint. Each of the prepaints, by themselves, are not intended to be paint by themselves but only after combination with other prepaint compositions.

Tsuei teaches and suggests coating compositions that by themselves may be used as paints. Accordingly, Tsuei teaches to form paints, not prepaints. Tsuei does not teach to add the other essential paint elements as a separate prepaint, but teaches to mix them all together. With reference to claim 207, for example, claim 207 recites an opacifying prepaint consisting essentially of an opacifying pigment, a dispersant, a thickener and water. To be used as a paint in Tsuei, however, additional essential components would be added. Because each of the individual independent claims rejected for obviousness recite prepaints, they are not obvious in light of the teachings and suggestions of Tsuei. Each of the respective dependent claims are allowable over Tsuei, among other reasons, for depending from allowable independent claims.

Accordingly, Applicants respectfully request that the obviousness rejections of claims 207-212, 232-234, 237, 243, 244, 301-303, 306, 313, 314, 316, 319, 320 and 327 be withdrawn.

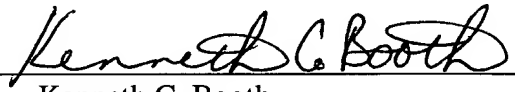
CONCLUSION

Applicant respectfully requests that a timely Notice of Allowance be issued in this case so that the Interference Request may be granted.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Date: April 15, 2005

By: 
Kenneth C. Booth
Reg. No. 42,342

SCHMEISER, OLSEN & WATTS LLP
18 East University Drive, #101
Mesa, AZ 85201
(480) 655-0073